

09182862-070401

## EXHIBIT 1

All communications respecting this case should identify it by number and names of parties.



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

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Filed by: Judge Jameson Lee

OCT - 8 1998

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OCT 13 1998

FLIESCHER, JUDS,  
MEYER & LOVEJOY

Interference No. 104,051

Applicant: Iwamoto  
Serial No.: 08/655,828  
Filed: 05/31/96  
FOR: SPECTACLE ACCESSORY  
MOUNTING DEVICE  
Accorded Benefit of: Japanese  
Application 07-156,856,  
filed 05/31/95, and Japanese  
application 08/153,172,  
filed 05/24/96

RE-DECLARATION OF INTERFERENCE

This interference is hereby re-declared as follows:

The count is modified as follows:

Count 1

In the alternative,

Iwamoto's application claim 1,  
or  
Chao's patent claim 1.

Claims corresponding to count 1:

Iwamoto: claims 1, 3, 4, 14, 21, 22, and 27-29  
Chao: claim 1

For count 1, Iwamoto is accorded the benefit of Japanese application 7-156,856, filed May 31, 1995, and Japanese application 8-153,172, filed May 24, 1996.

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Application No. 08/655,828  
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Count 2

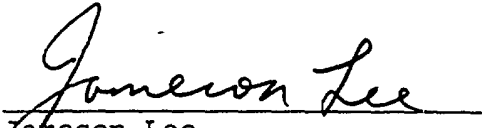
In the alternative,

Iwamoto's application claim 30,  
or  
Chao's patent claim 2.

Claims corresponding to count 2:

Iwamoto: claims 7-9, 15-18, 23-26, 30, and 31-47  
Chao: claim 2

For count 2, Iwamoto is accorded the benefit of Japanese application 7-156,856, filed May 31, 1995, and Japanese application 8-153,172, filed May 24, 1996.

  
Jameson Lee  
Administrative Patent Judge

09483662-070401

Application No. 08/655,828  
Chao v. Iwamoto

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## EXHIBIT 2

**CHAO V. IWAMOTO**  
**FLIESLER-032598-001**  
**INTERFERENCE NO. 104,051**  
**PLEADINGS FILE I**

<b>TAB #</b>	<b>DOCUMENT</b>	<b>DATE</b>
1	Re-Declaration of Interference Notice from PTO	10/08/98
2	Re-Declaration of Interference (Modification of Claims) PTO Notice	10/08/98
3	Replacement of Paper No. 1	10/22/98
4	Declaration of Interference	10/22/98
5	Order Revising Schedule for Filing of Preliminary Motions & Statements	10/22/98
6	PTO Order Pursuant to 10/22/98 Conference Call	10/22/98
7	Party Iwamoto Preliminary Statement	11/25/98
8	Party Iwamoto Preliminary Motion 2 37 CFR §§1.633 (a) and 1.639	11/25/98
9	Party Iwamoto's Preliminary Motion 3 (To add Claims to Senior Party Iwamoto's application, and designate such claims as corresponding to the counts, under 37 CFR §1.633(c)(2))	11/25/98
10	Party Chao's Preliminary Motion 3 37 CFR §1.633(a)/102(a) Motion	11/25/98
11	Party Chao's Preliminary Motion 4 37 CFR §1.633(c)(1) Motion	11/25/98
12	Party Chao's Objection to the Admissability of the Party Iwamoto's Evidence Contained in or Submitted With Its Preliminary Motions Under 37 CFR §1.633	12/03/98
13	PTO Order Pursuant to 12/04/98 Conference Call	12/07/98
14	PTO Response to Iwamoto Preliminary Motion 2	12/09/98
15	Party Chao's 37 CFR §1.624 Preliminary Statement (Revised)	12/10/98
16	Party Chao's Preliminary Motion 2 37 CFR §1.633(a)/112 & 102 Motion (Revised)	12/10/98
17	Party Chao's Preliminary Motion 5 37 CFR 1.633(h) Motion (Revised)	12/10/98
18	Party Chao's Preliminary Motion 6 37 CFR 1.633(g) Motion	12/10/98

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19	Party Iwamoto's Response to the Party Chao's Objection to the Admissibility of the Party Iwamoto's Evidence Contained in or Submitted with its Preliminary Motions Under 37 CFR §1.633	12/16/98
20	Party Iwamoto Preliminary Motion 4 (37 C.F.R. §§1.633(f) and (j))	12/16/98
21	Party Iwamoto Preliminary Motion 5 (To add claims to Senior Party Iwamoto's application, and to designate such claims as corresponding to the counts under 37 CFR §§1.633(c)(2) & (i)	12/16/98
22	Party Chao's Miscellaneous Motion #7 (To amend Motion #5)	12/16/98
23	The Party Iwamoto's Objections to the Admissibility of the Party Chao's Evidence Contained in or Submitted with Chao's Response to the APJ's Order of 12/09/98	12/21/98
24	Party Iwamoto Reply (Relating to Judge's Order Dated 12/09/98	12/21/98
25	The Party Chao's Objection to the Admissibility of the Party Iwamoto's Evidence Contained in or Submitted with its Preliminary Motions 4 and 5	12/25/98

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**PLEADINGS FILE II**

<b>TAB #</b>	<b>DOCUMENT</b>	<b>DATE</b>
26	PTO Order Regarding Iwamoto Motion 2	12/22/98
27	PTO Decision on Chao's Miscellaneous Motion 7	12/22/98
28	Party Iwamoto Preliminary Motion 1 (For Judgment based on prior art)	12/29/98
29	Party Chao's Opposition Re Documentary Evidence	12/31/98
30	Party Chao's Motion 8 (Request that the APJ Ignore or Discard an Inadvertently filed Draft)	12/31/98
31	Party Iwamoto Reply to Chao's Opposition Re Documentary Evidence (Relating to Judge's Order Dated 12/22/98)	01/06/99
32	Party Iwamoto's Response to the Party Chao's Objection to the Admissibility of the Party Iwamoto's Evidence Contained in or Submitted With Its Preliminary Motions 4 and 5	01/06/99
33	Party Chao's Response to the Party Iwamoto's Objections to Admissibility of Chao's Evidence	01/06/99
34	PTO Memorandum Opinion and Order	01/11/99
35	Party Iwamoto's Opposition 2 (To Chao's Preliminary Motion 2)	01/25/99
36	Party Iwamoto's Opposition 4 (To Chao's Preliminary Motion 4)	01/25/99
37	Party Iwamoto's Opposition 5 (To Chao's Preliminary Motion 5)	01/25/99
38	Party Iwamoto's Preliminary Motion 6 (37 CFR §§1.633 (a)-For Judgment Based on Inequitable Conduct)	01/25/99
39	Party Iwamoto's Motion for Leave to Belatedly File Iwamoto Preliminary Motion 6 (37 CFR §§1.635 and 1.645 (b))	01/25/99
40	Party Iwamoto Opposition 6 (To Chao Preliminary Motion 6)	01/25/99
41	Party Chao's Revised Opposition No. 1	01/25/99
42	Party Chao's Opposition No. 3	01/25/99
43	Party Chao's Opposition No.4	01/25/99

FOR FILING

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PLEADINGS FILE III**

<b>TAB #</b>	<b>DOCUMENT</b>	<b>DATE</b>
44	Party Chao's Opposition No. 5	01/25/99
45	Chao's Contingent Motion 9 (37 C.F.R. §1.634)	01/25/99
46	Iwamoto's Request to Cross-Examine Chao's Declarants On Oral Deposition	02/01/99
47	Party Iwamoto's Objections to the Admissibility of Chao's Evidence Contained in or Submitted with its Oppositions 1-5	02/01/99
48	Party Chao's Associate Power of Attorney by Attorney of Record Under 37 C.F.R. §1.34 (and Certificate of Service)	02/04/99
49	Party Chao's Designation of Lead Attorney	02/04/99
50	Party Chao's Notice of Service of Production of Documents	02/08/99
51	Party Chao's Response to Iwamoto's Second Objections to Evidence	02/16/99
52	PTO Order Regarding Testimony of Chao Brothers	02/19/99
53	Iwamoto Cover Letter Accompanying Deposition Transcript of Ira Lerner Requested by APJ Lee's Order of February 19, 1999	02/19/99
54	Iwamoto's Objections to the Admissibility of Chao's Exhibit 1111 Served With Chao's Response to Iwamoto's Second Objections to Evidence	02/23/99
55	Iwamoto's Notice of Deposition	02/26/99
56	Chao's Second Notice of Deposition	03/02/99
57	Chao's Request Pursuant to 37 CFR 1.672 (d)	03/03/99
58	Chao's Section 1.660 Notice of Litigation	03/08/99
59	Notice of Chao's Withdrawal of Request for Cross Examination	03/10/99
60	Iwamoto Miscellaneous Motion Requesting an Order Directing Chao to Provide David Chao's 1994 Day Panner for Testing By a Forensic Documentary Expert;	03/15/99
61	Proposed Order Stipulation and Proposed Order	03/16/99

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TAB #	DOCUMENT	DATE
62	PTO Order Re: Ink Testing Request & Deposition Transcripts	03/18/99
63	Iwamoto Submission of The Deposition Transcripts of David Chao and Richard Chao Pursuant to APJ Lee's Order of March 18, 1999	03/18/99
64	Iwamoto's Notice Under 37 CFR §1.602(c)	03/19/99
65	Iwamoto's Response to Order of March 18, 1999 Explaining Timeliness of Iwamoto's Request For Testing of David Chao's 1994 Day Planner By a Forensic Expert	03/19/99
66	Revised Chao's Revised Opposition 3	03/26/99
67	Revised Chao's Revised Opposition 5	03/26/99
68	Chao Miscellaneous Motion 9	03/26/99
69	Joint Miscellaneous Motion 1	03/26/99
70	Chao Reply 2 (To Iwamoto Opposition 2) (See separate file for exhibits)	03/29/99
71	Chao Reply 4 (To Iwamoto Opposition 2) (See separate file for exhibits)	03/29/99

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TAB #	DOCUMENT	DATE
72	Chao Reply 5 (To Iwamoto Opposition 2) (See separate file for exhibits)	03/29/99
73	Iwamoto's Reply No. 1 (To Chao's Opposition 1 and To Chao's Revised Opposition No. 1)	03/29/99
74	Iwamoto's Reply No. 3	03/29/99
75	Iwamoto's Reply No. 5	03/29/99
76	Iwamoto's Revised Preliminary Motion 2 (37 C.F.R. § § 1.633(a))	03/29/99
77	Iwamoto's Proposed Order Granting Iwamoto's Revised Preliminary Motion 2	03/29/99
78	Iwamoto's Objections to Chao's Evidence Referenced in Chao's Replies 2, 4 & 5	04/05/99
79	PTO Decision on Miscellaneous Motion	04/16/99
80	Chao's Opposition 2 (See folders for exhibits)	04/19/99
81	Chao's Response to Iwamoto's Objections to Chao's Evidence in Replies	04/19/99
82	Chao's Notice of Filing Exhibits Relied Upon in Opposition 2	04/21/99
83	Iwamoto Submission of the Evidence Relied Upon in Iwamoto Revised Preliminary Motion 2 Pursuant to APJ Lee's Request of April 21, 1999	04/21/99
84	Iwamoto Submission of The Audio Testimony of Richard and David Chao from the Depositions Conducted on February 24 and 25	04/21/99
85.	Decision on Iwamoto's Revised Preliminary Motion 2	04/23/99
86.	Iwamoto Request for Oral Hearing on Revised Iwamoto Preliminary Motion 1	04/29/99
87.	Iwamoto Request for Oral Hearing on Chao's Preliminary Motion 4 and Iwamoto Opposition 4	04/29/99

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**PLEADINGS FILE IV**

<b>TAB #</b>	<b>DOCUMENT</b>	<b>DATE</b>
88.	Iwamoto Request for Oral Hearing on Chao's Revised Preliminary Motion 5 and Iwamoto Opposition 5	04/29/99
89.	Iwamoto Request for Oral Hearing on Iwamoto Preliminary Motion 6	04/29/99
90.	Iwamoto Motion to Suppress the Testimony of Richard J. Samuels	04/29/99
91.	Iwamoto Motion to Suppress the Testimony of John William Morris, Jr.	04/29/99
92.	Iwamoto Motion to Suppress the Testimony of Icek Benz (Exhibits 1080 and 2091) Pursuant to 37 C.F.R. §1.635 and Order of Oct. 22, 1998, Paper No. 10	04/29/99
93.	Iwamoto's Observations with Respect to the Cross-Examination of John William Morris, Jr. (Whose Testimony is referenced in Chao Replies 4 & 5) Pursuant to Order of Oct. 22, 1998, Paper No. 10)	04/29/99
94.	Iwamoto's Observations with Respect to the Cross-Examination of Icek Benz (Whose Testimony is Referenced in Chao Replies 4 & 5) Pursuant to Order of Oct. 22, 1998, Paper No. 10	04/29/99
95.	Iwamoto's Observations with Respect to the Cross-Examination of Richard J. Samuels, (Whose Testimony is Referenced in Chao Replies 4 & 5) Pursuant to Order of Oct. 22, 1998, Paper No. 10	04/29/99
96.	Iwamoto's Observations With Respect to the Cross-Examination of Thierry Ifergen (Whose Testimony is Referenced in Chao Replies 4 & 5) Pursuant to Order of Oct. 22, 1998, Paper No. 10	04/29/99
97.	Chao Request for Hearing	04/29/99
98.	Iwamoto Request for Reconsideration of Decision on Miscellaneous Motion, Dated April 16, 1999 and Request to Preserve Evidence	04/30/99
99.	Iwamoto Request for Reconsideration of Decision on Iwamoto's Revised Preliminary Motion 2 (37 C.F.R. §1.640 (c))	05/07/99
100.	Chao's Response to Iwamoto's Observations of Ifergen's Examination	05/13/99

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PLEADINGS FILE V**

<b>TAB #</b>	<b>DOCUMENT</b>	<b>DATE</b>
101.	Chao's Response to Iwamoto's Observations of Prof. Morris' Cross Examination	05/13/99
102.	Chao's Opposition to Iwamoto's Motion to Suppress Morris' Testimony	05/13/99
103.	Chao's Response to Iwamoto's Observations of Prof. Samuels' Cross-Examination	05/13/99
104.	Chao's Opposition to Iwamoto's Motion to Suppress Benz's Testimony	05/13/99
105.	Chao's Response to Iwamoto's Observations of Benz's Cross-Examination	05/13/99
106.	Chao's Opposition to Iwamoto's Motion to Suppress Morris' Testimony	05/13/99
107.	PTO Response to Iwamoto Request for Reconsideration	05/24/99
108.	Reply to Chao's Opposition to Iwamoto Motion to Suppress the Testimony of John William Morris, Jr.	05/21/99
109.	Iwamoto's Reply to Chao's Opposition to Iwamoto's Motion to Suppress the Testimony of Icek Benz	05/21/99
110.	Reply to Chao's Opposition to Iwamoto Motion to Suppress the Testimony of Richard J. Samuels	05/21/99
111.	PTO Respone to Iwamoto's Request for Reconsideration on Iwmato's Preliminary Motion 2	05/26/99

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**CHAO V. IWAMOTO  
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INTERFERENCE NO. 104,051  
PLEADINGS FILE V**

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<b>TAB #</b>	<b>DOCUMENT</b>	<b>DATE</b>
112.	Chao Miscellaneous Motion 10	06/02/99
113.	Resubmission of Chao Opposition 2	06/15/99
114.	Chao Submission of Documents	06/15/99
115.	Submission of Richard & David Chao's Declaration Statements	06/16/99
116.	Decision on Chao's Miscellaneous Motion 10	06/10/99
117.	Office Action regarding reissue application	07/15/99
118.	Chao's Section 1.660 Notice of Litigation	06/29/99
119.	Iwamoto Notice of Filing Supplemental Information Disclosure Statement In U.S. Patent Application No. 08/655,828	10/13/99
120.	Decision on Miscellaneous Motions	2/8/00
121.	Joint Miscellaneous Motion No. 2	2/28/00
122.	Decision on Joint Miscellaneous Motion 2 and Setting of Oral Hearing Time	3/1/00
123.	Order Dismissing Motions, Authorizing Disclosure of Test Results, and for Entry of Adverse Judgment	4/7/00
124.	Settlement Agreement	
125.	Joint Request for Entry of Adverse Judgement Pursuant to 37 C.F.R. 1.662	05/26/00
126.	Joint Submission of Interference Settlement Agreement Pursuant to 37 C.F.R. 1.666(a) and Request to Keep Settlement Agreement Separate from File of Interference Pursuant to 37 C.F.R. 1.666(b)	05/26/00
127.	Judgement	05/30/00

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## EXHIBIT 3

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 149

Filed by: Trial Section Motions panel  
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

RICHARD CHAO

Junior Party,  
(Patent No. 5,568,207)

v.

TOSHIKAZU IWAMOTO

Senior Party.  
(Application 08/655,828)

Patent Interference No. 104,051

Before: McKELVEY, Senior Administrative Patent Judge, and SCHAFER  
and LEE, Administrative Patent Judges.

PER CURIAM

DECISION ON IWAMOTO'S  
REVISED PRELIMINARY MOTION 2

Introduction

By authorization from the Board, Iwamoto's original preliminary motion 2 was substituted by its revised preliminary motion 2 (Paper 134), to permit Iwamoto to rely on additional

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PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

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evidence obtained in connection with the taking of testimony of Messrs. David and Richard Chao. Hereinafter, revised preliminary motion 2 will be referred to simply as preliminary motion 2. Chao filed an opposition (Paper No. 145) and Iwamoto's reply is not yet due.

Preliminary motion 2 (page 2) states the relief requested as follows:

Senior party Iwamoto moves under 37 C.F.R. § 1.633(a) for judgment against junior party Chao because Richard Chao, the inventor named on the Chao patent, did not himself invent the subject matter claimed in claim 2 of the Chao patent, U.S. Patent No. 5,568,207, and because the Chao patent is invalid under 35 U.S.C. §§ 102(f), 116 and 256.

According to Iwamoto, inventorship of the Chao patent is incorrect. Iwamoto believes that Richard Chao, the sole named inventor on the Chao patent, did not solely invent the subject matter of claim 2, and that instead, David Chao is the true inventor of the subject matter of claim 2.

The motion is based largely on the direct testimony of Messrs. Richard and David Chao (Exhibit 1112), which was taken live in the presence of Judges Mckelvey and Lee who observed the demeanor of the witnesses. Testimony is usually not taken live in an interference proceeding, but in this case it was felt that it should be because inventorship and derivation are issues where the demeanor of the witnesses may be quite telling as to their

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credibility. In addition, the interrogation of Richard Chao was conducted in Mandarin Chinese through an interpreter. Because Judge Lee understands that foreign language it was beneficial for him to hear the actual questions and answers that were made in Chinese prior to their being interpreted into English. The entire live testimony was recorded on audio-tape.

Findings of Fact

1. The Chao patent is U.S. Patent No. 5,568,207, based on an application filed on November 7, 1995, and names Richard Chao as the sole inventor.
2. The Chao patent includes claims 1 and 2 which are drawn to an eyeglass device having a primary spectacle frame and an auxiliary spectacle frame. The auxiliary spectacle frame includes two side portions each having an arm extended therefrom for extending over and for engaging with an upper side portion of the primary spectacle frame.
3. Further according to claim 1, a first pair of magnetic members are secured in projections on the rear and side portions of the primary spectacle frame and a second pair of magnetic members are secured to arms extending from the two side portions of the auxiliary frame. The second pair of magnetic members are engaged with the first pair of magnetic members.

3. Claim 2 depends from claim 1 and further specifies that the second pair of **magnetic members** secured to the arms of the auxiliary spectacle frame **are extended downward** toward projections in the rear and side portions of the primary spectacle frame.

4. Figure 7 of the Chao patent illustrates an embodiment of the invention in accordance with the feature added by claim 2.

5. Live testimony of Messrs. Richard and David Chao was taken by direct examination on February 24 and 25, 1999, in the presence of Judges McKelvey and Lee.

6. Richard Chao came up with the idea within the scope of claim 1 in September or October of 1994 while taking a shower. (Exhibit 1112, page 191, lines 14-21).

7. Richard Chao considered his invention as that of creating a "hook" type engagement between the primary spectacle frame and the auxiliary spectacle frame. To Richard Chao, so long as the hook function is achieved, it did not matter to Richard Chao from what material the hook is made. (Exhibit 1112, page 206, lines 14-16).

8. After having initially thought of the idea of a hooked arrangement between the primary and auxiliary spectacle frames, Richard Chao shared his idea with other persons in discussions about his invention. The other persons included family members,

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for example, David Chao, a brother of Richard Chao. (Exhibit 1162, page 198, line 2 to page 199, line 22).

9. David Chao, after hearing Richard Chao's idea and discussing the same with Richard Chao, drew in his 1994 Day Planner, as an entry for September 5, 1994, a figure to depict what he thought Richard Chao had invented and communicated to him. (Exhibit 1105).

10. David Chao also drew in his 1994 day Planner, in the entry for October 20, 1994, another figure to depict what he thought Richard Chao had invented and communicated to him. (Exhibit 1106).

11. The drawings of David Chao on the September 5 and October 20, 1994, i.e., the entries of his Day Planner, illustrate a magnetic member extending downward from an auxiliary frame toward a projection on the primary spectacle frame holding a magnetic member, as does Figure 7 of the Chao patent. (Exhibits 1105 and 1106).

12. During testimony of David Chao, the following question and answer exchange occurred between Judge McKelvey and witness David Chao (Exhibit 1112, page 293, line 19 through page 294, line 20):

JUDGE MCKELVEY: Mr. David Chao, do you have the Chao patent in front of you?

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THE WITNESS: Yes, I do, Your Honor.

JUDGE McKELVEY: Would you look at figure 7, please.

THE WITNESS: Yes.

JUDGE McKELVEY: Do you understand what figure 7 is?

THE WITNESS: I understand.

JUDGE McKELVEY: Tell me what it is.

THE WITNESS: It describes a mechanism that has, sort of, like a stopper or a hook to further secure the auxiliary lenses on to the primary frame.

JUDGE McKELVEY: Is the item shown in figure 7 your idea?

THE WITNESS: No.

JUDGE McKELVEY: Whose idea do you think it is?

THE WITNESS: Richard Chao.

JUDGE McKELVEY: Did you [he] tell you about this idea?

THE WITNESS: Yes.

13. David Chao recalls his understanding from discussions with Richard Chao that there is a need to have something extended downward from the auxiliary spectacle frame to form a hook. He does not remember if Richard Chao told him something else.

(Exhibit 1112, page 298, lines 15-21).

14. Before the time he drew the figure in the September 5, 1994 entry in the Day Planner, David Chao does not remember

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whether Richard Chao told him that to form the hook there should be magnetic members extended downwardly. (Exhibit 1112, page 298, last line to page 299, line 7).

15. Richard Chao did not consider important the nature of the material which extends downwardly from the auxiliary frame to constitute a hook for engagement with the primary frame, so long as there is a hook. (Exhibit 1112, page 206, lines 10-16).

16. Richard Chao does not remember whose idea it was to extend the magnetic member in particular downwardly. (Exhibit 1112, page 207, line 15 to page 208, line 2). May be it was his and may be it was someone else's.

17. The following question and answer exchange occurred between Richard Chao and counsel for Iwamoto (Exhibit 1112, page 207, line 15 to page 208, line 2):

BY Mr. BERNSTEIN:

Q Whose idea was that to extend the magnetic downwardly?

A It might have been my idea, and it might have been some idea that came from our discussion.

Q From whose discussion?

A Well, the situation might have been, I discussed this with David and then we told this idea to the person who submitted the patent application for us.

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### Discussion

Judges Lee presided over, and Judge McKelvey attended, the entire live testimony of Messrs. Richard and David Chao. Thus, the panel has the benefit of Judge McKelvey's and Judge Lee's evaluation of the credibility of the witnesses based on their observation of the witnesses' demeanor under interrogation. It is their view that both witnesses are highly credible. Based on their testimony and the transcript as a whole, the panel is inclined to accord their testimony considerable weight. It is also Judge McKelvey's and Judge Lee's impression that the bare written transcript of the testimony (Exhibit 1112) does not give the full flavor or true scope of the testimony given. For instance, as will be explained later in context, when Richard Chao referred to "David's idea," he was merely referring by short-hand to the drawing made by David and contained in David's 1994 Day Planner and not making an admission that the idea originated from David.

The findings above reveal our view of the circumstances surrounding the inventorship issue in this case. On the record presently before us, Richard Chao came up with the idea of having a hooked engagement between the auxiliary frame mounted on top of a primary frame and the primary frame. Specifically, on this record, Richard Chao conceived of the idea of having arms

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extending from the side portions of the auxiliary frame to engage the upper side portion of the primary frame. This hooked engagement feature is an addition to the previously known idea that a pair of magnetic members on the auxiliary frame engages a pair of magnetic members on the primary frame. To Richard Chao, it was not important from what material the hook was made, so long as the hooked arrangement was made. The hook can be made from an extension of the magnetic members on the auxiliary frame or an extension of some other part of the auxiliary frame.

Richard Chao discussed his idea with David Chao and others and subsequent to these discussions the application which matured into the Chao patent was filed, including claim 2 which requires the magnetic members on the auxiliary frame to extend downwardly towards the primary frame for hooking onto the primary frame. Figure 7 of the patent illustrates an embodiment of claim 2.

David Chao does not remember whether Richard Chao had told him specifically that the magnetic members on the auxiliary frame should extend downwardly. Richard Chao also does not know for certain whether that specific idea originated with him or with David Chao. The only thing certain was that there were discussions between Richard and David about Richard's idea of a hooked engagement and then the application for patent was filed including claim 2. Either one could have proposed the idea.

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The inventorship as originally named on the Chao patent is presumptively correct. Iwamoto as the moving party bears the burden of proof to show that Richard Chao is not properly named as sole inventor. 37 CFR § 1.637(a). That burden is by a preponderance of the evidence. Bruning v. Hirose, 161 F.3d 681, 684-5, 48 USPQ2d 1934, 1938 (Fed. Cir. 1998). On the record before us, it might be possible to come up with a theory that the specific notion of extending the "magnetic member" downwardly from the auxiliary frame originated from David Chao and not Richard Chao. However, a contrary position is at least as plausible, particularly since David Chao disavows having made the invention of claim 2. Accordingly, it cannot be said, on this record, that Iwamoto's burden of proof by a preponderance of the evidence has been satisfied. In other words, we have not been persuaded that it is more likely true than not that the subject matter of claim 2 originated with David Chao. In our view, it is at least equally likely that claim 2 was an embodiment mentioned only briefly by Richard Chao in his discussions with David Chao.

Iwamoto points out that during the deposition of Richard Chao, "Richard testified that it was David Chao's idea to have the magnetic member extend downward" (Motion at 8). Specifically, on page 9 of preliminary motion 2, Iwamoto states:

After preparing these sketches (Exhibit 2066),  
Richard Chao pointed out his idea in contrast to  
David's idea:

THE WITNESS: This is my original idea. This  
is a stopper, and this is the magnetic  
member. (Indicating). This was stopper to  
stop it. (Indicating). This is David's idea.  
He used magnetic member here. (Indicating).

Transcript pp. 204:20-205:3.

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T04020-29329T50

However, Judges Mckelvey and Lee presided over the live  
testimony and understand the actual context in which the  
reference to David Chao's idea was made. It is clear to both of  
them that Richard's reference to "David's idea" merely  
identifies, by short-hand or abbreviation, the drawings that were  
made by David Chao in the September 5, and October 20, 1994  
entries of David Chao's Day Planner. In our view, consequently,  
Richard Chao's reference to "David's idea" was not an admission  
or an indication that David originally conceived of the idea to  
have the magnetic members on the auxiliary frame extend downward.  
While Richard Chao remembers that he first conceived of an  
embodiment using a non-magnetic stopper which extended  
downwardly, as we discussed earlier Richard Chao does not

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remember how the idea of having the magnetic members extend downwardly originated.

Iwamoto asserts that prior to the time that David Chao purportedly made the drawings which are entries in the September 5 and October 20, 1994 entries of his Day Planner, Richard Chao had not told David Chao that magnetic members should extend downward to form a hook. In support of that assertion Iwamoto quotes the following from David Chao's testimony (Exhibit 1162, page 296, line 16 to page 296, line 2):

[David Chao testifying]

Q During that discussion [with Richard Chao], did he [Richard Chao] tell you what the hook should be made from? What material the hook should be made from?

A No.

Q Did he tell you it should be a magnet?

A The hook should be a magnet?

Q Yes.

A No.

The above-quoted portion of David Chao's testimony does not support Iwamoto's assertion. First, the phrase "should be" in this context is more reasonably understood as "must" or at least "most preferably" and not simply as "can be." The question that

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should have been asked is whether Richard Chao told David Chao that the hook "can be" made by extending the magnetic members downwardly from the auxiliary frame. David Chao's "No" answer is consistent with Richard Chao's testimony that so long as the function of a hook is achieved, it does not matter from what material the hook is made. Neither a magnetic hook nor a non-magnetic hook is a must; either would be fine.

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Finally, Iwamoto argues that the authenticity of the drawings purportedly made by David Chao in the September 5 and October 20, 1994 entries in his day Planner are highly suspect and thus so is the credibility of David Chao. However, Iwamoto has not timely provided evidence to reasonably demonstrate that those entries were made not in 1994 but in 1998 after the declaration of this interference. On April 16, 1999, we entered a decision (Paper No. 143) denying as untimely Iwamoto's request to have David Chao's 1994 Day Planner provided for purposes of further ink-testing. On this record, its the law of the case that date on which the entries were made cannot be an issue.

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Conclusion

For the foregoing reasons, Iwamoto has failed to sustain its burden to prove that inventorship of the Chao patent has been incorrectly named or that Richard Chao derived the subject matter of claim 2 from David Chao. Furthermore, because we conclude that Iwamoto's preliminary motion 2 failed to establish a prima facie entitlement to relief, Chao's opposition has not been considered and is herein returned to Chao. There is no need for Iwamoto to file a reply. Iwamoto's preliminary motion 2 is denied.

Fred McKelvey  
Fred E. McKelvey, Senior )  
Administrative Patent Judge)

Richard E. Schafer  
Richard E. Schafer )  
Administrative Patent Judge)

Jameson Lee  
Jameson Lee )  
Administrative Patent Judge)

BOARD OF PATENT  
APPEALS  
AND  
INTERFERENCES

1. Name of the person		2. Address		3. Date of birth		4. Date of death		5. Date of burial		6. Date of cremation		7. Date of interment		8. Date of exhumation		9. Date of reinterment		10. Date of removal		11. Date of return		12. Date of disposal		13. Date of disposal		14. Date of disposal		15. Date of disposal		16. Date of disposal		17. Date of disposal		18. Date of disposal		19. Date of disposal		20. Date of disposal		21. Date of disposal		22. Date of disposal		23. Date of disposal		24. Date of disposal		25. Date of disposal		26. Date of disposal		27. Date of disposal		28. Date of disposal		29. Date of disposal		30. Date of disposal		31. Date of disposal		32. Date of disposal		33. Date of disposal		34. Date of disposal		35. Date of disposal		36. Date of disposal		37. Date of disposal		38. Date of disposal		39. Date of disposal		40. Date of disposal		41. Date of disposal		42. Date of disposal		43. Date of disposal		44. Date of disposal		45. Date of disposal		46. Date of disposal		47. Date of disposal		48. Date of disposal		49. Date of disposal		50. Date of disposal		51. Date of disposal		52. Date of disposal		53. Date of disposal		54. Date of disposal		55. Date of disposal		56. Date of disposal		57. Date of disposal		58. Date of disposal		59. Date of disposal		60. Date of disposal		61. Date of disposal		62. Date of disposal		63. Date of disposal		64. Date of disposal		65. Date of disposal		66. Date of disposal		67. Date of disposal		68. Date of disposal		69. Date of disposal		70. Date of disposal		71. Date of disposal		72. Date of disposal		73. Date of disposal		74. Date of disposal		75. Date of disposal		76. Date of disposal		77. Date of disposal		78. Date of disposal		79. Date of disposal		80. Date of disposal		81. Date of disposal		82. Date of disposal		83. Date of disposal		84. Date of disposal		85. Date of disposal		86. Date of disposal		87. Date of disposal		88. Date of disposal		89. Date of disposal		90. Date of disposal		91. Date of disposal		92. Date of disposal		93. Date of disposal		94. Date of disposal		95. Date of disposal		96. Date of disposal		97. Date of disposal		98. Date of disposal		99. Date of disposal		100. Date of disposal	
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Interference No. 104,051  
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McKelvey, senior Administrative Patent Judge, concurring.

I fully agree with the principal opinion, join therein and have signed it. I write separately to add some personal observations concerning the manner in which the issue before us was developed and resolved.

I.

There are certain cases where being able to observe live testimony is helpful, if not essential. Included are cases where the following issues arise (1) derivation, (2) fraud and inequitable conduct, (3) inventorship and (4) testimony given through a translator because the witness speaks a foreign language and not English. There may be other issues where live testimony can be helpful. In this case, both inventorship and testimony through a translator are involved. Cases where a witness does not speak English and must testify through a translator present unique challenges.

II.

In cases involving testimony given through a translator, apart from the witness and the translator, the other actors (attorneys and judges) can be:

- (1) Individuals who are fluent only in English;
- (2) Individuals who are fluent in English and the language in which testimony is being given (Mandarin Chinese in the case before us) and

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- (3) Individuals who are fluent in English and another language, but not the language in which testimony is being given.

An individual in category (1) may have a hard time asking questions in English which can in fact be translated into the language spoken by the witness. An English-only individual will not appreciate the fact that certain English-language questions cannot be translated into the foreign language in question. Likewise, the individual may not appreciate the fact that a literal translation of an English-language question does not necessarily mean the same thing in the foreign language.

An individual in category (2) will understand

- (a) what is being asked in English,  
(b) whether the translation into the foreign language is correct,  
(c) the answer given in the foreign language by the witness and  
(d) whether the answer given by the witness has been correctly translated into English.

The individual will know when literal translations of certain English-language questions (particularly those with legalese and patentese) do not have the same significance in the foreign language as they do in English. As applied to the facts of this case, Judge Lee falls into category (2).

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An individual in category (3) will have some appreciation as to whether the English-language question can be translated into the foreign language known by the individual. A category (3) individual will also appreciate that literal translations of English may not have the same significance in a foreign language. Thus, a category (3) individual may have a suspicion that a translation is not possible. I fall into category (3) being fluent in Spanish and having essentially no understanding of Chinese.

Compounding any language impairment, is the "American lawyer" way of asking questions. American lawyers tend to use legalese and to think of questions and answers in terms of legalese. In addition, patent attorneys tend to use patentese and to think of questions and answers in terms of patentese. But, witnesses, including witnesses with scientific credentials, do not normally think in legalese or in patentese.

There has been some recent experience at the board in cases where testimony has been through a translator. There came a time when I had an opportunity to preside over a cross-examination deposition in which an individual was testifying through a Japanese translator. At the outset, I was struck by the highly "technical" nature of the questions. Apart from being very long, the questions being asked by the American attorney included legalese such as "depositions," "interrogatories," etc. There was plenty of patentese too! Basically, the American attorney

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used words which probably would not have meant anything to the witness even if an assumption is made that those words can be translated. Perhaps more to the point, there came a time during the examination that I felt some of the answers to a series of questions were not consistent and were not particularly making sense. So, I asked the witness three questions, each worded differently in English. In my opinion, the three questions in English were essentially asking the same question, In an English-only context, the three questions should have resulted in essentially the same answer. However, by the time a translation of the questions had been made into Japanese and the answers in Japanese were translated back into English, the answers were basically "yes", "no" and "possibly." The reason I knew to ask the questions was because the attorney's line of questions could not readily be translated into Spanish. As a result, I suspected that a literal translation Japanese might change the significance of the question and therefore the meaning of the question to the witness in Japanese might not have the same English-language meaning which the attorney had intended. I asked the witness what the difference was between question 1 and question 2 and it became clear that translations of what I thought were essentially the same English questions ended up being different questions in Japanese. The bottom line is that counsel tread on very thin ice if they do not have assistance at counsel table of an individual

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who is fluent in the foreign language involved and perhaps as well with the case in general.

III.

A.

Richard Chao testified in Chinese.

Judge Lee is fluent in Chinese. The transcript of proceedings will show that Judge Lee on more than one occasion advised counsel for Iwamoto that the question needed to be re-asked (see, e.g., Ex. 1112, page 200, lines 11-12; page 203, line 19).

I am not fluent in Chinese. Nevertheless, even I knew that some questions being propounded by counsel for Iwamoto probably could not be translated into Chinese all the while maintaining the same meaning (see, e.g., Ex. 1112, page 108, lines 12-15; page 197, lines 13-14 and page 277, lines 4-11).

There came a time during the evidentiary hearing when Richard Chao testified as follows (Ex. 1112, page 205, line 12 through page 208, line 15):

Mr. BERNSTEIN: So then David's idea was to extend the magnet downwardly as the hook; is that correct?

A (Richard Chao): I don't know about David's idea.

Q But your original idea was to extend the flange downwardly, but not the magnet; is that correct?

A Yes, when I first told David about my idea, it was so.

Q I want to show you figure 7 of your patent. Item reference number 22, do you know what that is in figure 7?

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A Magnetic member.

Q Is that a magnet extending downwardly?

A Yes.

Q Was that your original idea?

A Here, it was the -- the idea of the hook was the reflected in the drawing. That was my original idea.

Q Right. But that's not my question, sir. My question is: The extension of magnet 22 downwardly, was that your original idea?

A As long as it reflects the idea of the hook, it's not important what material is used.

Q Again, that wasn't my question. My specific question is: Was the idea of extending the magnet downwardly, as magnet 22 is extended downwardly --

JUDGE McKELVEY: Mr. Bernstein, ask him if the magnet is extended downwardly.

Mr. BERNSTEIN: I'm sorry.

JUDGE McKELVEY: Let's try it that way.

Mr. BERNSTEIN: Does magnet 22 extend downwardly in figure 7 of the patent?

A When I first thought about this invention, I didn't think about having the magnetic member protruding downward.

JUDGE McKELVEY: The question is: Does the member 22 of figure 7 protrude downward?

THE WITNESS: Yes.

Mr. BERNSTEIN: Whose idea was that to extend the magnetic downwardly?

A It might have been my idea, and it might have been some idea that came from our discussion.

Q From whose discussion?

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A Well, the situation might have been, I discussed this with David and then we told this idea to the person who submitted the patent application for us.

Q So are you saying you don't remember whose idea it was to extend the magnet downwardly?

A The drawing was produced by the person who submitted the application.

Q Who was that person?

A A Mr. Chen.

Q Who is Mr. Chen?

A He helped us write the patent application in Taiwan.

B.

What is the significance of Richard Chao's testimony? To answer the question, you had to be at the evidentiary hearing.

Iwamoto says that because Richard Chao talked with others before the patent application was filed the "idea" of a downward projecting magnet (claim 2) must have come from someone else, probably David Chao. Iwamoto says so because Richard Chao has testified that "[i]t might have been my idea, and it might have been some idea that came from our discussion." The problem is that counsel for Iwamoto did not ask the right questions. If I have an idea and I show it to Mr. A, then Mr. A might say "well how are you going to make your idea?" I then have to come up with means to put my idea into practice and I remain sole inventor. Or, Mr. A might say "how are you going to commercialize your idea given element B of your proposed lens?"

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I then make changes to overcome Mr. A's commercialization observation and I remain sole inventor. On the other hand, Mr. A might say, "Gee, good idea, but let me make a suggestion that you use a magnet?" If the suggestion is a good one and I decide to include it in my application and claim it, then I maybe I am a joint inventor with Mr. A, at least to the embodiment with a magnet. The problem with Iwamoto's examination is that it does not reasonably rule out the possibility that Richard Chao came up with the magnet idea after discussing his idea with others. The mere fact that an inventor talks with others after having an idea does not mean that the inventor did not make the invention described and claimed in a patent.

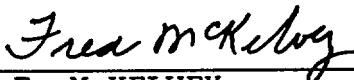
#### IV.

In this case, Iwamoto would have us draw one of two plausible conclusions from the evidence. But, there is a presumption that Richard Chao is properly named as inventor of the invention claimed in the Chao patent. Compare Brown v. Edeler, 110 F.2d 858, 861, 45 USPQ 181, 184 (CCPA 1940) (an application made by two or more persons claiming to be joint inventors is prima facie evidence of joint inventorship; see also Hamer v. White, 143 F.2d 987, 991, 62 USPQ 285, 288 (CCPA 1944)). Iwamoto was under a burden to establish by a preponderance of the evidence that Richard Chao is not properly named as sole inventor.

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Arguably for purpose of discussion, Iwamoto might make out a case based on the words of the transcript that Richard and David Chao should be named as joint inventors. But, it is equally, if not more, plausible that Iwamoto has failed to sustain its burden. Based on observation of the demeanor of the Chao's, there is little doubt in my mind that Iwamoto failed to sustain its burden. To the extent one might conclude there is a "tie," then the "tie" goes to Richard Chao. Compare Yamaha Int'l Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 1580 n.11, 6 USPQ2d 1001, 1008 n.11 (Fed. Cir. 1988) (the ultimate burden of persuasion [in a case where a party is under a burden to establish a fact by a preponderance of the evidence] is only critical in the situation where the evidence is so evenly balanced that no preponderance emerges. In that event, the party having the burden of persuasion necessarily loses).

FOIA b 7 - Dated 10/10/99

  
FRED E. MCKELVEY,  
Senior Administrative Patent Judge

23 April 1999  
Arlington, VA



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## EXHIBIT 4

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Filed by: Trial Section Motions Panel  
Box Interference  
Washington, D.C. 20231  
Tel: 703-308-9797  
Fax: 703-305-0942

Paper No. 185

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
(Judge Jameson Lee)

RICHARD CHAO

Junior Party,  
(Patent No. 5,568,207)

v.

TOSHIKAZU IWAMOTO

Senior Party.  
(Application 08/655,828)

Patent Interference No. 104,051

Before: McKELVEY, Senior Administrative Patent Judge, and SCHAFER  
and LEE, Administrative Patent Judges.

LEE, Administrative Patent Judge.

ORDER

Dismissing Motions, Authorizing  
Disclosure of Test Results, and  
for Entry of Adverse Judgment in 5 Months

In Paper No. 163, dated May 24, 1999, the Board authorized the parties to have certain sketches ink-tested by an independent expert provided that the results of the ink-testing not be

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T04020-29028160

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APR 7 - 2000

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

disclosed to either party until either (1) after judgment has been entered in this interference, or (2) authorization for disclosure is expressly given by the Board.

On April 6, 2000, at approximately 9:30 AM, a telephone conference was conducted between administrative patent judge Lee, Mr. Danny Huntington representing junior party Chao, and Messrs. Michael J. Fink and Bruce H. Bernstein representing party Iwamoto. The administrative patent judge was informed that the parties have in fact signed a settlement agreement which will result, in no more than 4 months, in a request by one of the parties for entry of adverse judgment and that all pending motions would either be moot or withdrawn. Counsel for the parties indicated that precisely which party will prevail depends on the results of the ink-testing that was performed previously in this interference by an independent expert, which results are now under seal by order of the Board, and on a series of procedures to be carried out by the parties once they find out the results of the ink-testing.

Pursuant to discussions during the telephone conference, the parties, through counsel, agreed that if the administrative patent judge now authorizes disclosure of the results of the ink-testing to the parties, cancels the hearing for preliminary motions scheduled later this month, and withholds from issuing a decision on pending motions, then adverse judgment may be entered by the Board against both parties on or after September

6, 2000, unless prior to that date, either party has filed a request for entry of adverse judgment.

Accordingly, based on the foregoing, it is

ORDERED that the results of the ink-testing referred to in Paper No. 163 may be unsealed and disclosed to the parties;

FURTHER ORDERED that on or after September 6, 2000, adverse judgment will be entered by the Board against both parties, unless either party has requested entry of adverse judgment against itself;

FURTHER ORDERED that the hearing on preliminary motions is canceled and no decision on preliminary motions will be rendered prior to September 6, 2000; and

FURTHER ORDERED that all pending preliminary and/or miscellaneous motions of both parties are dismissed, with prejudice.

*McK*  
\_\_\_\_\_  
Fred E. McKelvey, Senior )  
Administrative Patent Judge)

*Richard E. Schaffer*  
\_\_\_\_\_  
Richard E. Schaffer )  
Administrative Patent Judge)

*Jameson Lee*  
\_\_\_\_\_  
Jameson Lee )  
Administrative Patent Judge)

BOARD OF PATENT  
APPEALS  
AND  
INTERFERENCES

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T04020 2928T60

## EXHIBIT 5

Paper No. \_\_\_\_\_

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
(Administrative Patent Judge Jameson Lee)

RICHARD CHAO

**Junior Party,**  
(Patent No. 5,568,207)

v.

TOSHIKAZU IWAMOTO

**Senior Party.**  
(Application No. 08/655,828)

Patent Interference No. 104,051

JOINT REQUEST FOR ENTRY OF ADVERSE JUDGMENT  
PURSUANT TO 37 C.F.R. § 1.662

09182852-070401  
T04040-29828T60

Senior Party IWAMOTO and Junior Party CHAO hereby jointly request, and expressly agree to, an entry of adverse judgment against Senior Party IWAMOTO with respect to the counts of the above-identified interference, in accordance with 37 C.F.R. § 1.662(a).

Accordingly, the parties respectfully request the Board of Patent Appeals and Interferences to issue an order entering adverse judgment against IWAMOTO in accordance with 37 C.F.R. § 1.662(a).

If the Administrative Patent Judge has any questions regarding this Request, he is invited to contact the undersigned counsel at the below-listed telephone numbers.

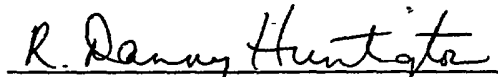
Respectfully submitted,

IWAMOTO, Senior Party



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Michael J. Fink, Esq., Reg. No. 31,827  
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CHAO, Junior Party



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1 MAY 26, 2000  
Date

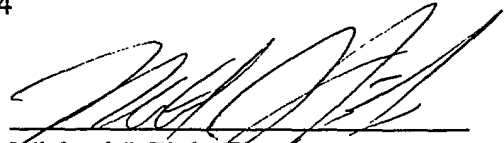
May 25, 2000  
Date

**CERTIFICATE OF SERVICE**

I hereby declare that a true copy of the foregoing JOINT REQUEST FOR ENTRY OF ADVERSE JUDGMENT PURSUANT TO 37 C.F.R. § 1.662, was served on Party CHAO this 26th day of May, 2000 by sending a copy of this paper via overnight courier service to the following address:

R. Danny Huntington, Esq.  
BURNS, DOANE, SWECKER & MATHIS, L.L.P.  
1737 King Street, Suite 500  
Alexandria, VA 22314

May 26, 2000  
Date

  
\_\_\_\_\_  
Michael J. Fink, Esq.  
Reg. No. 31,827  
Counsel for Senior Party IWAMOTO

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## EXHIBIT 6

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 189

Filed by: Trial Section Merits Panel  
Box Interference  
Washington, D.C. 20231  
Tel: 703-308-9797  
Fax: 703-305-0942

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

MAILED

RICHARD CHAO,

MAY 30 2000

Junior Party  
(Patent No. 5,568,207)<sup>1</sup>

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

v.

TOSHIKAZU IWAMOTO

Senior Party  
(Application 08/655,828)<sup>2</sup>

Patent Interference No. 104,051

Before SCHAFER, BARRETT and LEE, Administrative Patent Judges.

LEE, Administrative Patent Judge.

JUDGMENT

<sup>1</sup> Based on application 08/554,854, filed November 7, 1995. The real party in interest is Contour Optik, Inc.

<sup>2</sup> Filed May 31, 1996. Accorded the benefit of Japanese application 07-156,856, filed May 31, 1995, and Japanese application 08-153,172, filed May 24, 1996. The real party in interest is Asahi Kogaku Kogyo Kabushiki Kaisha. See Paper 129.

0918252-070404

The parties have filed a joint request for entry of adverse judgment, pursuant to 37 CFR § 1.662, against senior party Iwamoto. (Paper No. 187). The parties have also filed a settlement agreement and a joint request under 37 CFR § 1.666(b) to keep the settlement agreement separate from the file of the interference. (Paper No. 188).

The joint request to keep the settlement agreement separate from the file of the interference pursuant to 37 CFR § 1.666(b) is granted.

The joint request for entry of adverse judgment against senior party Iwamoto is granted.<sup>3</sup>

It is

**ORDERED** that judgment as to the subject matter of both counts 1 and 2 is herein entered against the senior party TOSHIKAZU IWAMOTO;

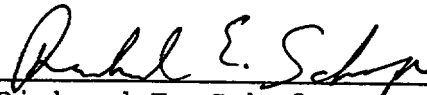
**FURTHER ORDERED** that the senior party TOSHIKAZU IWAMOTO is not entitled to its application claims 1, 3, 4, 14, 21, 22 and 27-29 which correspond to count 1; and

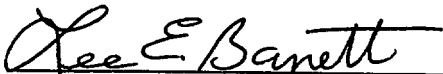
**FURTHER ORDERED** that the senior party TOSHIKAZU IWAMOTO is not entitled to its application claims 7-9, 15-18, 23-26, 30 and 31-47 which correspond to count 2.

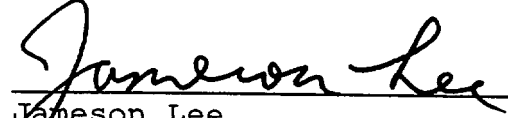
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<sup>3</sup> An order dated April 7, 2000, dismissed all then pending motions of both parties.

Interference No. 104,051  
Chao v. Iwamoto

  
Richard E. Schafer )  
Administrative Patent Judge )

  
Lee E. Barrett )  
Administrative Patent Judge )

  
Jameson Lee )  
Administrative Patent Judge )

BOARD OF PATENT  
APPEALS  
AND  
INTERFERENCES

104051-07401

Interference No. 104,051  
Chao v. Iwamoto

By Facsimile and Federal Express  
Counsel for Party Chao:

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P.O. Box 1404  
Alexandria, Virginia 22313-1404

Counsel for Party Iwamoto:

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Bruce Bernstein  
Greenblum & Bernstein  
1941 Roland Clarke Place  
Reston, Va 20191\*

104051-070401

09103062 070404  
T01020 29030T50

## EXHIBIT 7

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Reissue of

**Letters Patent 5,568,207**

**Richard CHAO**

Serial No.: 09/182,862

Filed: October 21, 1998

For: AUXILIARY LENSES FOR EYEGLASSES

Commissioner for Patents  
Washington, D.C. 20231

Examiner: H. Mai

Group Art Unit: 2873

**DECLARATION OF DAVID Y. CHAO PURSUANT TO 37 CFR § 1.131**

SIR:

**I David Y. Chao hereby declare that:**

1. I have a Bachelor of Science degree in Finance from the University of Maryland.

2. I am currently the Director of International Sales of Contour Optik, Inc., and have been the Director since 1996. I was the Sales Manager of Contour Optik Inc. between 1993 to 1996. My business address is 6 Industrial Fifth Rd., Tau-Chiauo Industrial Park, Chiayi Taiwan.



3. Contour Optik, Inc. manufactures and sells optical products. Contour Optik, Inc. is the assignee of 50% of the entire right, title and interest in and to U.S. Patent No. 5,568,207 ("the '207 patent"), which issued on October 22, 1996 to my brother, Richard Chao.
4. I am the same David Chao who testified under oath in Interference No. 104,051, involving the '207 patent, before Judges Lee and McKelvey in February 1999.
5. I understand that a reissue of the '207 patent is being sought, and I am familiar with at least claim 1 of the '207 patent and the reissue application.

04182862-070401  
104040-2982862

6. Prior to May 31, 1995, while I was working in Taiwan I made a first drawing entry into my Day Planner. The drawing entry illustrates a figure that depicts what I thought my brother Richard Chao had invented and communicated to me in Taiwan. (Chao Interference Exhibits 1105). (Exhibits 8)
7. I routinely take my Day Planner with me when I travel for business in my capacity as Director of International Sales. I also routinely took my Day Planner with me when I traveled for business in my capacity as Sales Manager for Contour Optik, Inc.
8. Prior to May 31, 1995, but after I sketched the drawing (the figure of Exhibit 8) referred to in ¶6 above, I traveled to the United States (the "US")(hereinafter the "first trip"). A copy of business records verifying that I was in the US prior to May 31, 1995 are attached as Exhibit 10. The business records include a copy of my American Express



Bill. The copy of my American Express Bill attached as Exhibit 10 has a closing date prior to May 31, 1995, and identifies the charges I made in California and Pennsylvania prior to May 31, 1995. A copy of charge receipts that I signed and received while I was in the US prior to May 31, 1995, and identified on my American Express Bill, are also attached as part of Exhibit 10. The Credit Card Number and dates have been redacted from these business records.

9. As is my customary practice, I had my Day Planner referred to in ¶ 6 above with me during my first trip to the US prior to May 31, 1995, which Day Planner included the illustration identified in ¶ 6 supra.

09182862-070401

10. Prior to May 31, 1995, but after I returned from my first trip to the US discussed in ¶ 8 above, and while working in Taiwan, I made a second drawing entry into my Day Planner which illustrates a figure which depicts what I thought my brother Richard Chao had invented and communicated to me while in Taiwan. (Chao Interference Exhibits 1106). (Exhibit 9). The second drawing entry into my Day Planner made prior to May 31, 1995, but after the first drawing entry into my Day Planner, illustrates, inter-alia, a magnetic member extending downward from an auxiliary frame toward a projection on the primary spectacle frame holding a magnetic member, as does Figure 7 of the Chao '207 patent.

11. Prior to May 31, 1995, but after I sketched the drawing figure of Exhibit 9, referred to in ¶ 10 above, I again traveled to the US (hereinafter the "second trip"). A copy a business

record verifying that I was again in the US prior to May 31, 1995 is attached as Exhibit 11, and includes a copy of my American Express Bill. The copy of my American Express Bill attached as Exhibit 11 has a closing date prior to May 31, 1995, and identifies charges I made in California and Virginia prior to May 31, 1995. The Credit Card Number and dates have been redacted from these business records.

12. As is my customary practice, I had my Day Planner with me during my second trip to the US prior to May 31, 1995, which Day Planner included the illustration identified in ¶ 10 supra.

13. Prior to May 31, 1995, I brought at least one prototype of a spectacle device having the "hook" type engagement between the primary spectacle frame and the auxiliary spectacle frame and in which a magnetic member extended downward from the auxiliary frame toward a projection on the primary spectacle with me when I traveled to the US.

14. That shortly before March 25, 1995, active exercise began and continued in a diligent effort toward reducing the inventive concepts illustrated in my Day Planner to practice in the US.

15. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18



of the United States Code and that such willful false statements may jeopardize the  
validity of the application or any patent issued thereon.

DATE: APRIL 19, 2001

  
David Y. Chao

09182862-070401

09182862-070404

## EXHIBIT 8

CHAO EXHIBIT 1105

CHAO V IWAMTO

INTERFERENCE 104,051

9 September

Week 37

5 Monday  
八月三十日 星期一

重要事項 Reminders  
新紀元雜誌出版日誌  
宜 新紀元雜誌出版日誌  
忌 新紀元雜誌出版日誌

REDACTED

新紀元雜誌出版日誌

新紀元雜誌出版日誌

6 Tuesday  
八月三十一日 星期二

重要事項 Reminders  
新紀元雜誌出版日誌  
宜 新紀元雜誌出版日誌  
忌 新紀元雜誌出版日誌

REDACTED

REDACTED

7 Wednesday  
九月一日 星期三

重要事項 Reminders  
新紀元雜誌出版日誌  
宜 新紀元雜誌出版日誌  
忌 新紀元雜誌出版日誌

REDACTED

REDACTED

REDACTED

8 Thursday  
八月二日 星期四

重要事項 Reminders  
新紀元雜誌出版日誌  
宜 新紀元雜誌出版日誌  
忌 新紀元雜誌出版日誌

REDACTED

9 Friday  
八月三日 星期五

重要事項 Reminders  
新紀元雜誌出版日誌  
宜 新紀元雜誌出版日誌  
忌 新紀元雜誌出版日誌

REDACTED

10 Saturday  
八月四日 星期六

重要事項 Reminders  
新紀元雜誌出版日誌  
宜 新紀元雜誌出版日誌  
忌 新紀元雜誌出版日誌

REDACTED

11 Sunday  
八月五日 星期日

重要事項 Reminders  
新紀元雜誌出版日誌  
宜 新紀元雜誌出版日誌  
忌 新紀元雜誌出版日誌

09182962-074404

## EXHIBIT 9

[illegible]

1	100%
2	98%
3	96%
4	94%
5	92%
6	90%
7	88%
8	86%
9	84%
10	82%
11	80%
12	78%
13	76%
14	74%
15	72%
16	70%
17	68%
18	66%
19	64%
20	62%
21	60%
22	58%
23	56%
24	54%
25	52%
26	50%
27	48%
28	46%
29	44%
30	42%
31	40%
32	38%
33	36%
34	34%
35	32%
36	30%
37	28%
38	26%
39	24%
40	22%
41	20%
42	18%
43	16%
44	14%
45	12%
46	10%
47	8%
48	6%
49	4%
50	2%
51	0%

[illegible][illegible]

Chao EXHIBIT 1106  
Chao v. Iwamoto  
Interference 104,051

REDACTED

09132363:070404

## EXHIBIT 10



# The Gold Card Summary of Account

EXHIBIT 10

Please retain this portion for your files.

Card Member Name

Account Number

Closing Date

DAVID YINKAI CHAO

Page 1 of 2

Previous Balance	Credits/Payments	New Charges	New Balance
\$ .00	\$ .00	\$652.81	\$652.81

Amex Ref. No.	Item No.	Listing of Charges and Credits	Charges	Credits
034266-1	001	THRIFTY CAR RENTAL LOS ANGELES CA INV#384806	116.53 ✓	
098281-1	002	DOLLAR RAC OF SO CAL LOS ANGELES CA INV#477258	183.75 ✓	
033283-1	003	B/W MONTEREY PARK INN MONTEREY PARK CA INV#159032	50.40 ✓	
501263-1	004	ALAMO RENT-A-CAR INC CHANTILLY VA 232836519 ALAMO RENT-A-CAR INC	253.72 ✓	
501266-1	005	HOUSE OF SHANGHAI LANCASTER PA 265211838 FOOD-BEV	22.30 ✓	
501268-1	006	BLOOMINGDALES TYSONS CORNER VA 142058725 MENS WOVEN SHIRTS	26.11 ✓	
ACCOUNT TOTAL			\$652.81	\$ .00

CH # 387



# The Gold Card

Card Member Name  
**DAVID YINKAI CHAO**

Account Number

Closing Date

Page 2 of 2

FRBF12033

S3

4593

ITEM 001  
THRIFTY CAR RENTAL LOS ANGELES CA

\$116.53

05/94 THRU 06/97 88 AX Register No. Approval Code  
DAVID YINKAI CHAO 6000 Dept. No. Salesperson  
1147672  
091684  
TOTAL 116.53  
00 384806 American Express® Cards

ITEM 002  
DOLLAR RAC OF SO CAL LOS ANGELES CA

\$183.75

05/94 THRU 06/97 88 AX Register No. Approval Code  
DAVID YINKAI CHAO 6000 Dept. No. Salesperson  
092894  
00 477258  
TOTAL \$183.75  
00 477258 American Express® Cards

ITEM 003  
B/W MONTEREY PARK INN MONTEREY PARK CA

\$50.40

05/94 THRU 06/97 88 AX Register No. Approval Code  
DAVID YINKAI CHAO 6000 Dept. No. Salesperson  
092994  
TOTAL \$50.40  
00 159032 American Express® Cards

ITEM 004  
ALAMO RENT-A-CAR INC CHANTILLY VA

\$253.72

Cardmember Account No.	Date of Charge	Reference Code	Approval Code
		091994	
Service Establishment and Location			
ALAMO RENT-A-CAR INC CHANTILLY		VA	
Record of Charge			
LOCATION	DATE/TIME		
RENTAL	AGREEMENT		
CHANTILLY	VA 09/00/00	232836519	
RETURN	TR#		
	263515		
S/E #	4453900581	TOTAL CHARGE AMOUNT	
		\$253.72	

ITEM 005  
HOUSE OF SHANGHAI LANCASTER PA

\$22.30

Cardmember Account No.	Date of Charge	Reference Code	Approval Code
		265211838	29
Service Establishment and Location			
HOUSE OF SHANGHAI LANCASTER		PA	
Record of Charge			
FOOD BEV	\$19.30		
TIP	\$3.00		
S/E #	2371048703	TOTAL CHARGE AMOUNT	
		\$22.30	

ITEM 006  
BLOOMINGDALES TYSONS CORNER VA

\$26.11

Cardmember Account No.	Date of Charge	Reference Code	Approval Code
		142058725	00
Service Establishment and Location			
BLOOMINGDALES TYSONS CORNER		VA	
Record of Charge			
MENS WOVEN SHIRTS			
ROC NUMBER	142058725	TAX	\$1.12
S/E #	4455700583	TOTAL CHARGE AMOUNT	
		\$26.11	

09102052-070404  
FOIA b7 - D

## EXHIBIT 11



# The Gold Card Summary of Account

Please retain this portion for your files

EXHIBIT 11

Card Member Name

Account Number

Closing Date

DAVID YINKAI CHAO

Page 1 of 2

Previous Balance	Credits/Payments	New Charges	New Balance
\$ .00	\$ .00	\$355.75	\$355.75

Amax Ref. No.	Item No.	Listing of Charges and Credits	Charges	Credits
501087-1	001	ROSS DRESS FOR LESS ESCONDIDO CA	70.60	
495094-1	002	00001498 CLOTHING AVIS RENT-A-CAR CHANTILLY VA	205.15	
501097-1	003	R/A# 700105114 AVIS RENT-A-CAR DFS WEST610 LA AIRPTLOS ANGELES CA	80.00	
		15030215 GIFTS/SUNDRIES		
		ACCOUNT TOTAL	\$355.75	\$ .00

FD4020-2962876

CH # 440

Payments or credits received after closing date above will appear on next month's statement

84 001 02.  
(1 )

Please see reverse side for important information regarding certain types of charges